

REMARKS/ARGUMENTS

Claims 1-30 are pending in the present application. Claims 26-30 are amended. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The examiner rejected claims 26-30 as indefinite under 35 U.S.C. § 112, second paragraph. Applicants have amended these claims accordingly, thereby overcoming the rejection.

II. 35 U.S.C. § 101

The examiner rejected claim 31 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed. The examiner asserts that claim 30 is not limited to tangible embodiments. No basis is present for holding a computer usable medium claim non-statutory because the medium may be allegedly “intangible.” For example, the MPEP provides that:

In this context, "functional descriptive material" consists of **data structures** and computer programs **which impart functionality when employed as a computer component**. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

MPEP 2106 (IV)(B)(1) (emphasis supplied).

Claim 31 is clearly functional descriptive material because it imparts functionality when employed as a computer component. Moreover, the functional descriptive material of claim 31 is recorded on “some” computer-readable medium.

In the above context, the term “some” means “any” computer-readable medium. The MPEP does not draw any distinctions between one type of media that is considered to be statutory and another type of media that is considered to be non-statutory. To the contrary, the MPEP clearly states that as long as the functional descriptive material is in “some” computer-readable medium, it should be considered statutory.

The only exception to this rule is functional descriptive material that does not generate a useful, concrete and tangible result, e.g., functional descriptive material composed completely of pure mathematical concepts that provide no practical result. Claims 31 clearly provides a useful, concrete and tangible result in that information is collected and reported across a network about an individual. This result is not a disembodied mathematical concept or an abstract idea.

Thus, claim 31 is directed to functional descriptive material that provides a useful, concrete and tangible result, and which is embodied on “some” computer-readable medium. Therefore, claim 31 is statutory and the rejection of the claims under 35 U.S.C. § 101 has been overcome.

III. 35 U.S.C. § 102, Anticipation

The examiner rejected claims 1-8, 19-22, 24-28, and 30 under 35 U.S.C. § 102 as anticipated by *Hoshi et al.*, System for Acquiring and Analyzing Personal Profile Data and Providing the Service of Delivering Various Information, U.S. Patent Application Publication 2002/0083043 (Jun. 27, 2002) (hereinafter “*Hoshi*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

III.A. Claims 1-8

Regarding claim 1, the examiner states that:

Hoshi discloses a system for collecting information about a user of an electronic consumable, comprising: an electronic consumable displayed using an apparatus, the apparatus having an input device and a sensor; wherein the sensor is activated by a user action to collect information about the user’s behavior as the user consumes the electronic consumable (page 3 paragraph 0058 and 0059, *Hoshi*).

Office Action of February 16, 2006, p. 3.

Claim 1 is as follows (emphasis supplied):

1. (Original) A system for collecting information about a user of an electronic consumable, comprising:
an electronic consumable displayed using an apparatus, the apparatus having an input device and a sensor;

wherein the sensor is activated by a user action to collect information about the user's behavior as the user consumes the electronic consumable.

Hoshi does not anticipate claim 1 because *Hoshi* does not teach the claimed feature that “the sensor is activated by a user action to collect information.” The examiner asserts otherwise, citing from *Hoshi*. The paragraphs cited by the examiner are as follows:

[0058] In yet another aspect of the present invention, at least either a sensor system or an actuator system is connected to each node, and control is carried out so that at least either the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation.

[0059] Accordingly, the user can monitor the results of sensor-based measurement or detection on the screen and operate with the actuator system of interest from the screen.

Hoshi, paragraphs 0058 and 0059.

In these paragraphs *Hoshi* teaches that a control is carried out so that at least the output screen of the sensor system is provided according to the user's operation. Similarly, control is carried out so that at least the operation screen of the actuator system is provided according to the user's operation. *Hoshi* then appears to assert that these functions allow the user to monitor the results of sensor-based measurement or detection and then operate the actuator accordingly.

However, on its face, the above-cited text does not teach that the sensor *is activated* by a user action to collect information, as claimed in claim 1. *Hoshi* does not teach in any way *how* the sensor is activated. Instead, *Hoshi* implies strongly that the sensor is always operational and is used as described in paragraphs 0058 and 0059 and as elsewhere described. Additionally, *Hoshi* does not teach anywhere that the sensor *is activated* by a user action to collect information, as claimed in claim 1. Thus, *Hoshi* does not anticipate claim 1.

Because claims 2-8 depend from claim 1, the same distinctions between *Hoshi* and claim 1 can be made for these claims. Additionally, claims 2-8 claim other additional combinations of features not suggested by the reference. For example, *Hoshi* does not teach that by activating the input device the user causes the information to be collected, as claimed in claim 4. *Hoshi* does not teach that the user activates the sensor by manipulating an object of the electronic consumable, as claimed in claim 5. *Hoshi* does not teach that the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function, as claimed in claim 6. The examiner's assertions to the contrary are manifestly incorrect based on the plain text of *Hoshi*. Consequently, the rejection of claims 1-8 have been overcome.

III.B. Claims 19-22, 24-28, and 30

Regarding claim 19, the examiner states that:

Hoshi discloses a method of collecting information about a user of an electronic consumable, comprising the steps of: storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable; in response to a user action, collecting information about the user (page 3 paragraph 0058 and 0059, *Hoshi*), wherein the information is collected according to embedded code in an object of the electronic consumable (paragraph 0146-0147, *Hoshi*); and reporting the information across a network (Figure 12 and paragraph 0144, *Hoshi*).

Office Action of February 16, 2006, p. 5.

Claim 19 is as follows (emphasis supplied):

19. (Original) A method of collecting information about a user of an electronic consumable, comprising the steps of:
storing an electronic consumable on an apparatus, the apparatus providing means for displaying the electronic consumable;
in response to a user action, collecting information about the user, *wherein the information is collected according to embedded code in an object of the electronic consumable*; and
reporting the information across a network.

Hoshi does not anticipate claim 19 because *Hoshi* does not teach the claimed feature that “the information is collected according to embedded code in an object of the electronic consumable.” The examiner asserts otherwise, citing from *Hoshi*. The paragraphs cited by the examiner are as follows:

[0146] In addition to the cache memory, the node 11 may be provided with another memory 13 for regularly storing user-specific data items, as necessary, including the profile data of the user 2 and advertisement and information content based on the profile data, so that the node 11 autonomously and selectively reads out necessary content in response to remote controller operation by the user 2 and shows them on the TV screen.

[0147] Furthermore, a plurality of sensors 14 for on-demand remote monitoring by the user 2, such as thermometers and cameras, and a plurality of actuators 15 for remote operation by the user 2, such as switches and control mechanisms, are connected to the node 11 as necessary.

Hoshi, paragraphs 0146 and 0147.

In paragraph 0146 *Hoshi* teaches that a node, which is usually a TV or VCR, is provided with memory for storing user-specific data. User specific data includes the profile data of the user, as well as advertisement and information content based on the profile data. The node autonomously and selectively reads out content in response to remote controller operation by the user. In an apparent non-sequitur, *Hoshi* teaches in paragraph 0147 that sensors for on-demand remote monitoring are connected to the node as necessary. *Hoshi* describes the use of these sensors elsewhere.

However, these paragraphs do not teach that “the information is collected according to *embedded code in an object of the electronic consumable*,” as claimed in claim 19. *Hoshi* never mentions embedded code in an object of the electronic consumable. *Hoshi* does not use any language that would imply the presence of embedded code. *Hoshi* does not use any language that would imply the presence of an object of the electronic consumable. For example, nowhere does *Hoshi* teach that embedded code is present in an object of the television program or other content information. Instead, *Hoshi* only teaches that memory associated with the node can contain user-specific data that the node uses to read out content in response to user input. This concept has nothing to do with *collecting information according to embedded code in an object of the electronic consumable*, as claimed in claim 19. In other words, *Hoshi* teaches that content is selected according to user profile data, but *Hoshi* does not teach that information is collected according to embedded code in an object of the content. Accordingly, *Hoshi* does not anticipate claim 19.

Claim 25 contains features similar to those presented in claim 19. Therefore, *Hoshi* does not anticipate claim 25 for the same reasons that *Hoshi* does not anticipate claim 19. Additionally, *Hoshi* does not anticipate claims 20-22, 24, 26-28, and 30 at least by virtue of the fact that these claims depend from claims 19 or 25. Additionally, claims 20-22, 24, 26-28, and 30 claim other additional combinations of features not suggested by the reference. For example, *Hoshi* does not teach that the object of the electronic consumable can only be stored in containers that allow the embedded code of the object to function, as claimed in claim 30. Consequently, it is respectfully urged that the rejection of claims 19-22, 24-28, and 30 have been overcome.

III.C. Claims 1-8, 19-22, 24-28, and 30

Hoshi does not anticipate claims 1-8, 19-22, 24-28, and 30 for the reasons presented above. Furthermore, *Hoshi* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Hoshi* and the features of the claimed inventions, one of ordinary skill in the art would not be led to modify *Hoshi* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Hoshi* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants’ disclosure as a template to make the necessary changes to reach the claimed invention.

IV. 35 U.S.C. § 103, Obviousness

The examiner rejected claims 9-18, 23, 29, and 31 under 35 U.S.C. § 103 as obvious over *Hoshi* in view of *Fedorovskaya et al., Imaging Method and System*, U.S. Patent Application Publication 2004/0101212 (May 27, 2004) (hereinafter “*Fedorovskaya*”). This rejection is respectfully traversed.

With respect to claim 9, the examiner states that:

Hoshi disclose a system for collecting information about a user of an electronic consumable, comprising: an apparatus capable of displaying an electronic consumable; an electronic consumable comprising documents and objects; wherein the documents and objects include instructions for automatically monitoring and reporting user behavior; and wherein a user action triggers the monitoring and reporting of the user behavior (paragraphs 0058, 0059 and 0239, *Hoshi*).

Hoshi does not explicitly disclose monitoring and reporting user behavior as claimed.

Fedorovskaya teaches monitoring and reporting of user behavior (paragraph 0036 and 0047, *Fedorovskaya*).

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of the cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, *Fedorovskaya*). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, *Fedorovskaya*).

Office Action of February 16, 2006, pp. 8-9.

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In this case, the examiner has failed to state a *prima facie* obviousness rejection of claim 19 because the proposed combination does not teach all of the features of claim 19.

Claim 19 is as follows (emphasis supplied):

19. (Original) A method of collecting information about a user of an electronic consumable, comprising the steps of:
storing an electronic consumable on an apparatus, the apparatus
providing means for displaying the electronic consumable;
in response to a user action, collecting information about the user,
wherein the information is collected according to embedded code in an object of the electronic consumable; and
reporting the information across a network.

The proposed combination does not teach all of the features of claim 19 because neither *Hoshi* nor *Fedorovskaya* teach or suggest that the information is collected according to embedded code in an

object of the electronic consumable, as claimed. Nevertheless, the examiner asserts that *Hoshi* does teach this claimed feature, citing from *Hoshi* as follows:

[0058] In yet another aspect of the present invention, at least either a sensor system or an actuator system is connected to each node, and control is carried out so that at least either the output screen of the sensor system or the operation screen of the actuator system is provided according to the user's operation.

[0059] Accordingly, the user can monitor the results of sensor-based measurement or detection on the screen and operate with the actuator system of interest from the screen.

Hoshi, paragraphs 0058 and 0059.

As described above, these paragraphs teach that a control is carried out so that at least the output screen of the sensor system is provided according to the user's operation. Similarly, control is carried out so that at least the operation screen of the actuator system is provided according to the user's operation. *Hoshi* then appears to assert that these functions allow the user to monitor the results of sensor-based measurement or detection and then operate the actuator accordingly.

However, nothing in the cited text teaches or suggests that information is collected *according to embedded code* in an *object of the electronic consumable*. The fact that "control is carried out" to allow the user to see the results of sensor-based measurements is wholly irrelevant to whether information is collected according to embedded code in an object of the electronic consumable itself. Certainly, *Hoshi* does not teach that information is collected according to embedded code in an object of the TV program or information content displayed on the television or VCR. Thus, *Hoshi* does not teach all of the features of claim 19 as asserted by the examiner.

Nevertheless, the examiner also refers to the following portion of *Hoshi*:

[0239] By installing a camera or cameras in the room, it is also possible to determine who among the family members is watching the TV.

Hoshi, paragraph 0239.

This section of *Hoshi*, on its face, is wholly irrelevant to whether information is collected according to embedded code in an object of the electronic consumable, as claimed in claim 19. In fact, nowhere does *Hoshi* teach or suggest this claimed feature. Additionally, *Fedorovskaya* does not teach this claimed feature, and the examiner does not assert that *Fedorovskaya* teaches this claimed feature. Because neither reference teaches or suggests this claimed feature, the proposed combination does not teach or suggest all of the features of claim 19. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 19.

In addition, the examiner has failed to state a *prima facie* obviousness rejection against claim 19 because the examiner failed to state a proper motivation to combine the references. A proper *prima facie*

case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). In this case, the examiner has not provided a proper teaching, incentive or suggestion supporting the combination.

Regarding a reason to combine the references, the examiner states that:

It would have been obvious to one of ordinary skill in the art of data processing at the time of the present invention to combine the teachings of the cited references because the analysis of the captured user behavior would lead to an accurate profiling of the users (paragraph 0062, *Fedorovskaya*). Furthermore, the classifications of emotions portrayed in pictures help in reviewing the information (paragraph 0009, *Fedorovskaya*).

Office Action of February 16, 2006, p. 9.

The examiner asserts that it would have been obvious to combine the references because the analysis of captured behavior would lead to an accurate profiling of the users and that the classifications of emotions portrayed in pictures help in reviewing the information. However, the examiner has only stated a purported advantage of combining the reference. An advantage, by itself, is insufficient to provide a teaching, suggestion, or motivation to combine the references to achieve the claimed invention. For example, the examiner cannot merely pick and choose elements from the prior art simply because an advantage exists to combine the references.

To constitute a proper teaching, suggestion, or motivation, the examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the combination, even if he or she recognized the advantage, and so no teaching, suggestion, or motivation exists to combine the references.

In the case at hand, the examiner has not provided a sufficient reason why one of ordinary skill would have a reason to implement the proposed advantage. The examiner states that “the analysis of the captured user behavior would be more accurate.” However, the examiner does not state that one of ordinary skill would have a reason to implement the proposed advantage. In the case at hand, one of ordinary skill would be motivated to avoid combining the references because large amounts of memory and processor power, hence a large expense, would be required to implement profiling a user’s emotions

and facial expressions. The examiner provided no reason to overcome this reason to avoid combining the references.

Furthermore, the examiner provided no reason why the purported increased accuracy is necessary or even desirable. For example, *Hoshi*'s method is complete in and of itself for the purpose *Hoshi* intends. *Hoshi*'s method does not require "increased accuracy." Given the lack of a need for increased accuracy, and given the increased costs of implementing the technology described in *Fedorovskaya*, one of ordinary skill would have no reason to combine the references to achieve the invention of claim 19. Thus, again, no teaching, suggestion, or motivation exists to combine the references to achieve the invention of claim 19. Certainly, the examiner has not offered a proper teaching suggestion, or motivation to combine the references to achieve the invention of claim 19.

For the reasons presented above, the examiner has failed to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 19.

V. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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